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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/867,301	05/29/2001	Robert H. Scheer	31083.05US4	6151
34018	7590	07/29/2004	EXAMINER	
GREENBERG TRAUIG, LLP 77 WEST WACKER DRIVE SUITE 2500 CHICAGO, IL 60601-1732			JASMIN, LYNDIA C	
			ART UNIT	PAPER NUMBER
			3627	

DATE MAILED: 07/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/867,301

Applicant(s)

SCHEER, ROBERT H.

Examiner

Lynda Jasmin

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[Signature]

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 18 is/are allowed.
- 6) ☒ Claim(s) 1,2,5-17 and 19 is/are rejected.
- 7) ☒ Claim(s) 3 and 4 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Amendment received May 13, 2004 has been acknowledged.

Claim Rejections - 35 USC § 101

2. Claim 1 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim, the recited process must somehow apply, involve, use, or advance the technological arts. In the present case, claim 1 only recites an abstract idea. The recited steps of merely receiving an advance demand notice and using a network of intelligent agents to move physical items specified in the demand notice does not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper. These steps only constitute an idea of how to fulfill an order in a supply chain.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case, the claimed invention fulfills order in a supply chain over a plurality of geographic locations (i.e., repeatable) and moves physical items specified in an advance demand notice to at least one of the plurality of geographic locations (i.e., useful and tangible).

Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claim 1 is deemed to be directed to non-statutory subject matter.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 10, 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 10, the recitation "the staging of the physical items" lacks proper antecedent basis.

In claim 14, the recitation "using the current and developing states of inventory" lacks proper antecedent basis.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 1, 2, 5-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Elston (2002/0143655 A1).

Elston et al. discloses a method for fulfilling an order in a supply chain that is distributed over a plurality of geographic locations (via directory for all locations or geographic region for customer places an order with one physical outlet among a group of affiliated merchants for fulfillment) with the steps of: receiving an advance demand notice representative of the order that includes a specification of one or more physical items of interest to the customer (via large

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group orders place in advance see box [0189]), and using a network of intelligent agents (via transaction managers or owner) to move the physical items specified in the advance demand notice within the supply chain (via moving to a pick up location or delivery time designed).

Elston et al. further discloses extracting information from a customer maintenance system to create the advance demand notice (via adding customer to a grouping list), and using an equipment knowledge base (via a remote ordering system).

Elston et al. further discloses coordinating with a carrier to move the physical items within the supply chain (inherently recited via order delivery to a customer-selected location or type of transaction: pick up or delivery at customer location). Further, monitoring the movement of the physical items within the supply chain (via the ordering delivery system 40) and forming alternative fulfillment plan (via alternative remote order process flow), ordering product from a supplier to initiate the moving of items within the supply chain (via the remote ordering system), using a customer defined level of service to move the items specified in the advance demand notice (see [00180]), using the current and developing states of inventory within the supply chain to move the items specified in the advance demand notice within the supply chain and taking into account a desired level of safety stock when moving the items specified in the advance demand notice within the supply chain (see boxes [0259-0265]).

Elston et al. fails to explicitly disclose moving the physical items as a function of a probability of need for each item. However, on of ordinary skill in

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the art at the time the invention was made would have included the probability of need of an item in calculating the optimum scheduling of orders or computation of wait time as disclose in Elston et al. since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art.

8. Claim 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Edwards (2002/0156695 A1).

Edwards discloses a method for fulfilling orders in a supply chain that is distributed over a plurality of geographic locations (via global supply contract) with the steps of receiving a first customer order specifying plans to purchase physical items (via pre-established contracts such as key terms that generally include a list of products/services that an Operating Equipment Maintenance 110 has agreed to sell to company 105) having a probability of need of 100 percent (such as approve line items), receiving a second customer order specifying plans to purchase physical items having an uncertain probability of need (via OEMs 110 may offer products and services that are still useful to a company but no pre-established pricing arrangement has been set between the company and OEM).

Although Edwards does not explicitly disclose determining probability of need to move items within the supply chain to simultaneously fulfill the first customer order and the second customer order. It is well known in the business art to forecast customers ordering in order to fulfill the need of each particular customer based on inventory depletion. Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have

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provided the procurement and fulfillment of items for each company under the pre-establish contracts, and the Examiner takes official notice as such.

Allowable Subject Matter

9. Claims 3 and 4 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

10. Claim 18 is allowed.

11. The following is a statement of reasons for the indication of allowable subject matter: The prior art of record fails to teach or suggest determining, using an equipment knowledge base, a probability that each of the physical items, in a work order that specifies a piece of equipment to be repaired, will be needed to effect the repair procedure as recited in independent claim 18. Further, the prior art of record fails to teach creating an advance demand notice order in response to a change in a schedule maintenance work order as recited in depend claim 4.

Response to Arguments

12. Applicant's arguments with respect to claims 1-19 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Crampton et al. (6,415,196 B1) a manufacturing

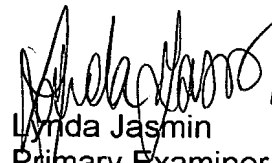
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scheduling process via selecting a plan for achieving demand in an optimal order and evaluating if the plan will work. Jenkins et al. discloses a method for ensuring order fulfillment and ensuring that a company is carrying the right inventory at the right locations.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lynda Jasmin whose telephone number is (703) 305-0465. The examiner can normally be reached on Monday- Friday (8:00-5:30) alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert P Olszewski can be reached on (703) 308-5183. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Lynda Jasmin
Primary Examiner
Art Unit 3627
7/25/04

lj